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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/394,230	09/13/99	GUNDERSON K	39338200160O

HM12/0719
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EXAMINER	
FORMAN, B	
ART UNIT	**PAPER NUMBER**
1655	20

DATE MAILED: 07/19/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action	Application No. 09/394,230	Applicant(s) GUNDERSON ET AL.	
	Examiner BJ Forman	Art Unit 1655	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 April 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires *3* months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☒ The proposed amendment(s) will not be entered because:

 (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);

 (b) ☐ they raise the issue of new matter (see Note below);

 (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

 (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

 NOTE: *see attached Continuation of Advisory Action*.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☐ The a)☐ affidavit, b)☐ exhibit, or c)☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☒ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

 The status of the claim(s) is (or will be) as follows:

 Claim(s) allowed: _____.

 Claim(s) objected to: _____.

 Claim(s) rejected: *1-18*.

 Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other:

Continuation of Advisory Action

The amendments will not be entered because they raise new issues which would require further search and consideration i.e. determining the presence of a mutation "without sequencing the target polynucleotide".

Response to Arguments

Applicant argues that the prior art references do teach or suggest modification or combinations of their teachings to arrive at the claimed invention. In response to applicant's argument that there is no suggestion to combine or modify the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one skilled in the art to modify the hybridization analysis of Cantor with the comparison and analysis of Yershov for the expected benefit of simplified diagnostics with enhanced reliability as taught by Yershov (Abstract).

Applicant argues that both Cantor and Yershov teach away from the use of a complete set of n-mers. This argument is not found persuasive because Cantor specifically teaches use of a complete set of n-mers in Example 2, Column 12, line 55-Column 13, line 30). Additionally, Yershov teach a complete 8-mer i.e. 65,536 (page 4913, right column, first full paragraph, lines 6-13) and they clearly suggest microchips containing a complete set of n-mers (page 4917, right column, lines 13-15 and last paragraph). It is noted that Applicant points to embodiments of Cantor which do not require complete sets of n-mers. However, Cantor clearly suggests use of complete n-mers by example (Example 2).

The arguments regarding the claims as amended drawn to determining the presence of a mutation without sequencing the target polynucleotide have been considered but are deemed moot in view of the non-entered amendments.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BJ Forman whose telephone number is (703) 306-5878. The examiner can normally be reached on 6:45 TO 4:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones can be reached on (703) 308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-8724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

BJ Forman, Ph.D.
July 18, 2001

STEPHANIE W. S. DUNSER
PRIMARY EXAMINER